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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,239	10/16/2003	Michael Gilfix	AUS920030360US1	8992

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EXAMINER	
THOMAS, JASON M	

ART UNIT	PAPER NUMBER
2423	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/687,239	GILFIX ET AL.	
	Examiner	Art Unit	
	Jason Thomas	2423	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 November 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 4-10, filed November 25, 2008, with respect to the rejection(s) of claim(s) 1-4, 6-8 and 10 under 35 U.S.C. Section 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new grounds of rejection is made in view of Katcher et al., U.S. Patent No. 7,120,924 B1 (hereinafter Katcher).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3 and 5-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Katcher.

Regarding claim 1: Katcher discloses a method and system for delivering interactive advertising content which comprises (see [abstract], [col. 4, ll. 14-48]): receiving a selection signal indicating that a user has selected an item displayed on a television screen wherein the item has associated interactive advertising

content; responsive to receiving the selection signal, identifying the selected item; (see [fig. 1], [col. 14, ll. 22-32], [cols. 17-18, ll. 64-11] for selecting); and displaying the associated interactive advertising content (see [col. 18, ll. 12-55] for displaying advertising content which includes the brand name, model, price, local vendor, etc.)

Regarding claim 2: Katcher discloses the limitations of claim 1 including further comprising receiving and storing advertising data that associates the selected item with a screen region and with interactive advertising content (see [cols. 1-2, ll. 50-3] for receiving and storing annotation and mask data).

Regarding claim 3: Katcher discloses all of the limitations of claim 2 including wherein receiving the advertising data comprises receiving the advertising data encoded in a video signal that includes a video image of the item (see [col. 4, ll. 34-48] for receiving the video image of the item).

Regarding claim 5: Katcher discloses wherein the advertising data includes instructions for control of the display of interactive non-intrusive advertising content for the item (see [abstract], [col. 4, ll. 34-48], [col. 11, ll. 34-67] for advertising data which includes instructions for display control).

Regarding claim 6: Katcher discloses all of the limitations of claim 1 further comprising: receiving one or more designation signals, wherein each designation signal represents an instruction to designate an item having associated non-intrusive interactive advertising content; responsive to receiving each designation signal, designating singly, as a currently designated item, each

of a multiplicity of items having associated non-intrusive interactive advertising content; wherein identifying the selected item comprises identifying as the selected item the currently designated item (see [fig. 1], [fig. 5], [col. 4, ll. 34-48], [col. 12, ll. 10-42], [col. 14, ll. 22-32]).

Regarding claim 7: Katcher discloses all of the limitations of claim 6 including wherein designating singly each of a multiplicity of items further comprises logically designating an item and visually designating an item (see [figs. 1a-1d], [fig. 5], [fig. 12, ll. 10-42], [col. 14, ll. 22-32] for visual and logical designations).

Regarding claim 8: Katcher discloses all of the limitations of claim 7 including wherein logically designating an item comprises setting a designation data element in advertising data for the item (see [abstract], [col. 4, ll. 34-37], [fig. 5], [fig. 12, ll. 10-42], [col. 14, ll. 22-32]).

Regarding claim 9: Katcher discloses wherein visually designating an item comprises displaying descriptive text for the item (see [fig. 1] for descriptive text).

Regarding claim 10: Katcher discloses all of the limitations of claim 7 including wherein visually designating an item comprises changing a video display of the item (see [fig. 1], [col. 17, ll. 64-2] for changing the appearance of the video display item).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katcher in view of Broadwin et al. U.S. Patent No. 5,929,850 (hereinafter Broadwin).

Regarding claim 4: Katcher does is silent regarding wherein the advertising data is encoded in a digital data stream separate from a video signal and receiving the advertising data comprises receiving the data stream through a digital network.

Broadwin teaches transmitting advertising data on a separate digital data stream (see [fig. 10] for a media server which transmits on a digital network; [col. 3, ll. 24-43], [col. 3, ll. 62-64], [col. 6, ll. 9-17], [col. 13, ll. 13-30] for a media or web server which maintains advertising data content).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the communication system of Katcher by providing a means of transmitting additional advertisement content via a separate means of communication as taught by Broadwin in order to allow access to a greater selection of advertisement content not in the original program stream.

4. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katcher, in view of Wistendahl et al. U.S. Pre-Grant Pub. No. 2002/0056136 A1 (hereinafter Wistendahl).

Regarding claim 11: Katcher does not teach tracking a cursor position on the television screen, wherein identifying the selected item comprises identifying the selected item in dependence upon the cursor position when the selection signal is received.

Wistendahl teaches the use of a mouse or other pointing device which is tracked to correlate the screen coordinates of the pointing device with what the user has selected (see [0015], [0016], [0042], [0067], [0088]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the methods of interacting with the items on the screen using a selection device as taught in Katcher by using a pointing device which can track screen coordinates as taught by Wistendahl in order to provide a more efficient means of selecting an item on the screen.

Regarding claim 12: The combined teachings of Katcher, in view of Wistehdahl, teach wherein the identifying the selected item in dependence upon the cursor position further comprises determining whether the cursor position is within a screen region associated with the item (see [0015], [0016], [0042], [0067], [0088] for determining whether a pointing device or cursor is aimed at a hot spot (screen region associated with the item) or at positions of objects).

Regarding claim 13: The combined teachings of Katcher, in view of Wistehdahl, teach wherein the advertising content comprises a web page describing the item and offering an on-line sale of the item (see [0043], [0064] initiating an internet connection to a WWW service which offers an item for purchase).

Regarding claim 14: The combined teachings of Katcher, in view of Wistehdahl, teach wherein displaying the associated non-intrusive interactive advertising content comprises downloading a web page from a remote web site identified in a link associated with the selected item (see [0043], [0064] where a web page can be downloaded through a link associated with a selected item).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Kitsukawa et al., U.S. Pre-Grant Pub. No. 2002/0059590 A1 – Kitsukawa teaches the concept of linking advertisements to program scenes received along with the TV program broadcast signal.

In view of the arguments filed on November 25, 2008, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth above.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Andrew Y Koenig/
Supervisory Patent Examiner, Art Unit 2423
.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Thomas whose telephone number is (571) 270-5080. The examiner can normally be reached on Mon. - Thurs., 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Koenig can be reached on (571) 272-7296. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J. Thomas

/Andrew Y Koenig/
Supervisory Patent Examiner, Art Unit 2423